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10/764,892

01/26/2004

Tsutomu Okada

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11/28/2006

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,892

Applicant(s)

OKADA, TSUTOMU

Examiner

Matthew J. Kasztejna

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3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 5, 2006 has been entered.

Notice of Amendment

In response to the amendment filed on September 5, 2006, amended claim 2 and canceled claim 1 are acknowledged. The following reiterated grounds of rejection are set forth:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-7 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto et al. (U.S. Patent No. 6,059,719).

In regard to claims 2-7 and 11-13, Yamamoto et al. teach a medical instrument system 1 using a diathermic snare and an endoscope in combination with each other, the endoscope including an inserting section which is to be inserted into a body cavity,

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and includes a distal end and a proximal end, and a cylindrical cap section 6A mounted on the distal end of the inserting section, the cap section having a distal end, a proximal end and an engagement projection, wherein the engagement projection includes a bent portion which is bent inward at the distal end of the cap section (see Figs. 1-2); wherein the diathermic snare comprises: a flexible sheath 23 having a distal end and a proximal end; an operation wire 22 inserted into the flexible sheath to be movable forwards and backwards, and having a distal and a proximal end; a snare wire 94 coupled to the distal end of the operation wire, and including a loop section 93 which expands to loop (see Fig. 7); an operating section 12 coupled to the proximal end of the flexible sheath, the operating section including a guide member and a slider, the guide member, extending in axial direction of the flexible sheath, the slider being movable forwards and backwards in the axial direction of the flexible sheath, and coupled to the proximal end of the operating wire; and a distal-end bent portion provided at the distal end of the loop section and bent in a direction that intersects a plane formed by the loop section; wherein the slider is moved forwards along the guide member, loop section of the snare wire is projected from the distal end of the sheath, the snare wire expands to loop and the loop section expands along the inner circumference surface of the engagement portion, and when the slider is moved backwards along the guide member, the loop section of the snare wire is retreated into the sheath; and wherein the loop section expands along the inner circumference of the projection, the distal-end bent portion conforms to a corner of the bent portion of the engagement projection, and extends

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along an inner circumferential wall of the distal end of the cap section (see Figs. 9-12 and 15 and Col. 10, Lines 5-67).

Claims 2-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakada et al. (U.S. Patent Application Publication No. 2001/0053909)

In regards to claims 2-7 and 11-16, Nakada et al. teach a diathermic snare used in combination with an endoscope, the endoscope 3 including an inserting section 4 with is inserted into a body cavity and which has a distal end and a proximal end, and a cylindrical cap section 1 mounted on the distal end of the inserting section, the cap section having a distal end, a proximal end and an engagement projection having a bending portion that bends inward at the distal end of the cap section (see Figs. 1 and 3), wherein the diathermic snare comprises: an elongate flexible sheath 9 having a distal end and a proximal end; an operating wire inserted into the sheath so as to move forward and backward and having a distal end and a proximal end; a snare wire 16b coupled to the distal end of the operating wire and having a loop section which expands like a loop (see Fig. 4); an operating section coupled to the proximal end of the sheath and including a operating section coupled to the proximal end of the sheath and including a guide member extending in an axial direction of the sheath and a slider which moves forward and backward in the axial direction of the sheath along the guide member and which is coupled to the proximal end of the operating wire; the loop section of the snare wire projecting from the distal end of the sheath, the snare wire expanding like a loop, and the loop section expanding along an inner circumference of the engagement projection when the slider moves toward along the guide member (see

Figs. 3-6) ; and a bending portion provided at the distal end of the loop section, the bending portion ending in a direction that intersects a plane formed by the loop section and conforming to a corner of the bending portion of the engagement projection when the loop expands along the inner circumference of the projection (see Figs. 1 and 5-6); wherein the cap section has an inclined plane corresponding to a plane of the cap section which is inclined to the axial direction of the sheath and the bending portion of the loop section bends in the axial direction of the sheath (see Figs 7-8).

In regards to claims 8-10 and 17-18, Nakada et al. teach a diathermic snare used in combination with an endoscope, wherein cap section has an inclined plane corresponding to a plane of the distal end of the cap section which is inclined to the axial direction of the sheath; and the bending portion of the loop section bends in the axial direction of the sheath (see Figs 7-8).

Response to Arguments

Applicant's arguments filed September 5, 2006 have been fully considered but they are not persuasive.

Applicant states neither Yamamoto or Nakada disclose or suggest any structural element corresponding to a "distal-end bent portion bent in a direction that intersects a plane formed by the loop section". However, both Yamamoto and Nakada disclose an apparatus having a bent portion which is bent inward and intersects a plane formed by the loop section of the respective snares, as both snare loops are movable in both forward and backward directions and thus form an unlimited number of planes which may intersect the distal-end bent portion which is bent inwards towards the snare loops

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(see Figs. 9-12 of Yamamoto and Figs. 3-10 of Nakada). Thus as broadly as claimed, both Yamamoto or Nakada disclose a structural element corresponding to a "distal-end bent portion bent in a direction that intersects a plane formed by the loop section".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

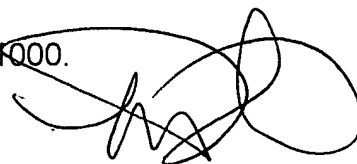
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK



11/21/06



LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
GROUP 8/00